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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,365	12/15/2000	Guy Roche	2000_1650A	8934

7590

09/08/2003

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EXAMINER

SANTIAGO, MARICELI

ART UNIT

PAPER NUMBER

2879

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/736,365	ROCHE ET AL.	
	Examiner	Art Unit	
	Mariceli Santiago	2879	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 13-20 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 10-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6,7</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 15-20, drawn to an enamel composition and plasma display panel comprising the enamel composition, classified in class 313, subclass 587.
- II. Claims 10-12, drawn to a method of improving the wettability of white pigments, classified in class 106, subclass 312.
- III. Claims 13-14, drawn to a process for enameling a glass substrate, classified in class 428, subclass 210.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the thermal deactivation of white pigments can be accomplished by other heating process not particular to the temperature and time ranges claimed. The subcombination has separate utility such as white pigment composition for latex based paint or the like.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product, for instance the enamel composition can be applied to any surface, not exclusively a glass substrate, using an alternative adequate medium, such as a paste, and under different temperatures and time intervals as than those claimed.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated since they are not disclosed as capable of use together since the method of improving the wettability of white pigments of Group II have different modes of operation, different functions, or different effects than the process for enameling a glass substrate of Group III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, further, the search required for Group I is not required for Group II or III, and because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 1-9 and 15-20 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 13 and 14,

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directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined.

Process claims 13 and 14 are hereby rejoined and fully examined for patentability under 37 CFR 1.104. Claims 10-12, not directed to the process of making or using the patentable product, will not be rejoined.

Drawings

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention, particularly, the embodiments as stated in claims 15-20.

Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

Allowable Subject Matter

Claims 1-9 and 13-20 are allowed over the prior art of record.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claim 1, and specifically comprising the limitation a layer forming constituents 70 to 97% by weight of glass frit composition having a softening temperature of less than 600°C and 3 to 30% by weight of a particulate whitening material, characterized in that a particulate whitening material, consists of at least 50% by weight of one or more thermally deactivated white pigments, 0 to 50% by weight of other white pigments and 0 to 20% by weight of one or more opacifiers.

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Regarding claims 2-9 and 13-20, claims 2-9 and 13-20 are allowable for the reasons given in claim 1 because of their dependency status from claim 1.

Other Prior Art Cited

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariceli Santiago whose telephone number is (703) 305-1083. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (703) 305-4794. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382. Additionally, the following fax phone numbers can be used during the prosecution of this application (703) 872-9318 (for response before a Final Action) and (703) 872-9319 (for response after a Final Action).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Wshgo 8/22/03
Mariceli Santiago
Patent Examiner
Art Unit 2879

[Signature]
VIP PATEL
PRIMARY EXAMINER